

REMARKS

Claims 1-11, 13-27, 29-44 and 46-48 are pending in the present application and have been examined. All of the pending claims have been rejected over Funk (US Patent 5,832,463). Claim 1 has been amended hereby. Applicants respectfully request reconsideration of the present application.

Claim 1 has been amended to correct a typographical error contained therein. This amendment has been made to correct the form of the claim and is not made in response to any statutory requirement.

Each of independent claims 1, 27 and 40 require:

- A) electronically capturing first transaction data reflecting transactions conducted by a teller;
- B) forwarding paper documents associated with the transactions to a back office location;
- C) generating second transaction data reflecting information contained on the paper documents; and
- D) linking the first and second transaction data with respect to a common financial transaction, and processing the first and second transaction data.

The Office Action states, and Applicants admit, that Funk discloses the first step of electronically capturing the first transaction data. With respect to the remainder of the steps explicitly recited in each of the independent claims though, the Office Action states that Funk discloses that it is common practice to perform the remainder of the steps.

Although it is true that Funk discloses that the prior art taught steps B and C as recited in all of the independent claims, Funk discloses this prior art in its Background of the Invention section. Funk then goes on to explicitly say that one should not perform steps B and C. Funk thus expressly teaches away from the present invention. The entire system of Funk is designed to eliminate the handling of paper. Specifically, Funk states that:

“At the time of presentment, all the relevant information associated with the check is in electronic or digital form, **therefore the need for maintaining and handling the paper check becomes obsolete.** The paper check may be truncated or marked in some way to indicate that it has been processed and **returned to the customer.** The customer may then do as he/she pleases with the check. He/she may keep it for a number of years **or discard it.**” (column 3, line 61-column 4, line 2)
[Emphasis Added]

As advised in MPEP Section 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garloch, Inc.*, 721 F. 2d 1540, 220 U.S.P.Q. 303 (Fed.Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The Federal Circuit thus states that the Office could not ignore the portion of Funk that would lead one skilled in the art away from the claimed invention. As described above, Funk expressly states not to perform steps B and C of the present invention. Applicants cannot think of a more clear-cut example of teaching away than as is presented in the Funk reference.

Furthermore, neither Funk nor the prior art disclosed in Funk teach step D of linking the first and second transaction data and performing the processing on the first and second transaction data as is expressly recited in each of the independent claims of the

present application. The prior art disclosed in Funk never generates the first transaction data and Funk never generates the second transaction data, therefore, neither the prior art discussed in Funk nor Funk teach the steps of linking the two types of data and performing processing on the two types of data. Furthermore, it would not be obvious to one skilled in the art to combine the disparate teachings of the first and second data because as discussed above, Funk expressly teaches that the second transaction data should never be generated.

As Applicants have shown that Funk expressly teaches away from the present invention as expressly recited in all of the claims of the present application, Applicants respectfully request withdrawal of the rejections of all of the claims on the basis of the Funk reference.

As each of the claims of the present application are currently in condition for allowance, such action is earnestly solicited.

Dated: August 11, 2003

Respectfully submitted,

By

Michael J. Scheer

Registration No.: 34,425

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas
41st Floor

New York, New York 10036-2714
(212) 835-1400

Attorney for Applicant